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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/602,869	06/23/2000	Jay S. Walker	99-081	9644

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EXAMINER

PIERCE, WILLIAM M

ART UNIT PAPER NUMBER

3711

DATE MAILED: 03/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/602,869

Applicant(s)

WALKER ET AL. 

Examiner

William M Pierce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26-72 is/are pending in the application.
- 4a) Of the above claim(s) 28-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26,27 and 38-72 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

  
WILLIAM M. PIERCE  
PRIMARY EXAMINER

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**DETAILED ACTION****DETAILED ACTION**

Claims 28-37 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 4, however, made an election to advance the prosecution of the case.

***Claim Rejections - 35 USC § 112***

Claims 26, 27, 38-42, 46, 50, 52, 56, 64-66, 70 and 72 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

. As to claims 26 and 27, "a specific score" and "instead of a players hand" is inferential since a score for a player's hand and selecting a players hand has not been previously recited. To correct claims 26 and 27 it is suggested that a Jepson format be used to remove inferential in unclear language. While it is noted that the preamble of the claims has been amended to recite "having a game outcome that depends at least in part on a predetermined point total", such falls way short of limiting the claim to a Blackjack type game. In fact, since most games "depend in part" upon a predetermined point total, the limitation is considered so broad as to have little affect on limiting the scope of the claim. In claims 26 and 27, how a game is physically "depends at least in part on a predetermined point total" is unclear. A "player's hand" and "dealer's hand" is inferential since how they can be compared is not set forth. The steps required by "playing a dealer's hand" are inferential. This is a scope of claim problem where one would be required to guess as to the steps to play the game that fall before, between and after the steps of "allowing", "dealing" and "comparing".

Claim 38 is unclear since a "count value" of what is not stated. Further that a player "may receive" a card by chance is indefinite in the sense that this defines every card game. In ln. 6, "the player" lacks a proper antecedent. "A hand of the dealer" is inferential since steps of cards and dealing "hands" is not recited. "The predetermined count value" lacks a proper antecedent since it has only been previously functionally recited. The scope of claim 39 is unclear since many variations of "blackjack" is known. Claims 40 and 41 are rejected as set forth above with respect to claims 38 and 39. In claim 42, "a hand of a dealer" is inferential since no hands or dealers are recited. The scope of the steps of "twenty-one" is unclear since many variations of the game are known. How a score can be "associated with the player" is unclear since by definition it means, "to join" and/or "connect in the mind". Claims 46 is inferential since a "chip placement area" implies a table surface which has not been set forth. The physical steps

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required by a score to be "represented by a game piece" are not clear. In claims 50, 52 and 64-66, the steps required for "adjusting" is not clear. In claim 56, the step of determining is inferential since one must infer that a hand exists and what it comprises. For the reasons set forth above, "twenty-one" and "associated with" render the claim unclear. In claims 70 and 72, a "game of blackjack" is unclear in scope since many variations of this type of game are known. The step of "receiving a request" is indefinite since it is previously recited in the alternative. A player may select only "receiving a hand comprising at least one card". "A hand of a dealer" is inferential.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Keller.

Shown is a blackjack game allowing a player to select a specific score, such as 4+5 or "dealer breaks", and comparing to the dealers hand in the case of "dealer breaks" and to the player's hand in the case of 4+5 to determine a winner.

Claims 26, 27, 38 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Alvarez.

As to claim 26 and 27, shown is a "predetermined point total" of 1-40 for example, allowing a player to select a specific score on a ticket 12, "dealing and playing a dealer's hand" by the lottery computer selecting numbers and comparing this hand to a players score to determine a winner.

Claims 26, 27 and 38-72 are rejected under 35 U.S.C. 102(b) as being anticipated by Keller.

Keller shows a player selecting a "specific score on the "players betting palette" and comparing that to the dealers hand (for example dealer breaks) to determine the winner of the game.

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**Conclusion**

Applicant's arguments filed 12/20/02 have been fully considered but they are not persuasive.

With respect to the term "associated", applicant has merely amended using the alternative word "depends" which does nothing to correct the indefiniteness of using such language. The structural relationship of how steps or elements are related must be positively set forth. Something the "depends" on something is so broad as to encompass everything under the sun when considered in argument, especially when one follows this with "depends at least in part". The corner stone of 35 USC 112 is that one be able to determine the metes and bounds of a claim. Whether or not this claim is limited merely to games such as black jack is unclear. One could question whether or not it includes Baccarat. Even games such as bridge depend upon a "predetermined point total". Arguably one would have to question whether or not this claim would cover such a game.

Applicant further does not understand how the claims are considered indefinite. Clearly the steps of allowing, dealing and playing are positively recited. However, for the step of a claim to be definite, the physical steps required to be performed must be clear. Merely "playing a dealer's hand" for example leaves one at a loss as to what must physically be done according to the claim. While one knows that in blackjack, for example, the steps required for dealing a dealer's hand requires a one card face up and one card face down, these steps cannot be inferred to be included in the claim. They further infer steps have taken place such as a player being offered a "player's hand" or that he has the option of playing a "player's hand" in the alternative to selecting a specific score. Likewise, how a "dealer's hand" is considered to have a "score" must be inferred in order to compare it to determine a winner. More definitely the sum of the indicia on the cards dealt to the dealer are compared to the specific number selected by the player to be his final "score". Hence, one reading the claims should not have to guess as to whether or not certain steps that are alluded to have or have not occurred. This speculation required renders the metes and bounds of the claims in question. While applicant suggests that "various examples...are set forth in the specification", this does not render the claim definite. Well known is that limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969).

As to claim 38, the recitation of "a count value" in the specification does not render it clear since such limitation are not read into the claims. See *In re Prater* above.

That a player "may receive a card" is based on the fact that 35 USC 112 requires that the metes and bounds for the claim must be clear. When a step in a claim is set forth so broadly that one cannot determine what it is intended to cover, the claim is considered indefinite, since the resulting claim does not clearly set forth the metes and

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bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989).

As to "the player", ln. 2 of the claim refers to "a player" in a functional recitation. Lns. 5 and 7 of the claim refer to a specific "the player". Whether or not it is the player that received the wager in ln. 2 is not clear.

As to claim 38 and "specific entry" extending beyond the scope of the specification has not been sustained and is considered moot. The remaining grounds for rejection concerning claim 38 are set forth above.

With respect to claims 39-42, 56, 70 and 72 it has been set forth above that the metes and bounds for a claim must be clear.

Claims 47, 50, 52 and 64-66 it is recited above that the specification will not be read into the claims.

As to Alvarez, the claim does not define what is considered to be a "specific score" or a "dealer's hand". Alvarez shows a specific score as being the numbers selected by a player and the dealer's hand to be the numbers selected by the lottery game. No limitation in the claims precludes such an interpretation of Alvarez. Likewise to claim 38, the outcome of the game in Alvarez is based on the numbers selected by the player as being his specific entry of a predetermined count value usually ranging from numbers 1-40 and the dealer's score selected by the lottery.

As to claim 27, in Alvarez, the player selects his specific score a plurality of numbers "instead of a dealer's hand", dealing a players hand in the outcome of the lottery and comparing them to determine the winner.

As to claim 40, a "rule" by nature is not considered a positive limitation. Should the claim be amended to positively require physical steps requiring cards, this grounds for rejection will be considered overcome.

As to Keller a player is allowed to select a specific entry, such as "4+5" or "21 bet" and this entry is compared to the dealers hand to determine a winner. Keller shows a "side bet" game where these wagering options are evaluated "instead of" the player's or dealer's hand. The claims fail to distinguish over Keller.

This is a RCE of applicant's earlier Application No. 09/602,869. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and

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the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry not concerning the merits of the case such as **missing papers, copies, status or information** should be directed to Tech Center 3700 Customer Service Center at (703) 306-5648 where the fax number is (703) 308-7957 and the email is Customerservice3700@uspto.gov.

For **official fax** communications to be officially entered in the application the fax number is (703) 305-3579.

For **informal fax** communications the fax number is (703) 308-7769.

Any inquiry of a general nature or relating to the **status** of this application or proceeding can also be directed to the receptionist whose telephone number is (703) 308-1148.

Any inquiry concerning the **drawings** should be directed to the Drafting Division whose telephone number is (703) 305-8335.



WILLIAM M. PIERCE  
PRIMARY EXAMINER